

REMARKS

Claims 1-17 were pending in the above-identified application prior to entry of this Amendment. In this amendment, claims 14-17 have been cancelled. Claims 1 and 13 have been amended. Accordingly, after entry of this amendment, claims 1-13 are pending in this case. The changes to the claims do not constitute the addition of new matter and full support for the changes may be found in the specification and claims as originally filed.

The Examiner did not consider two PCT International Search Reports, PCT/IB03/004926 and PCT/EP94/02387, cited on the Information Disclosure Statement submitted on March 26, 2004. These references cited under "Non Patent Literature Documents" correspond to the Search reports for WO 04/043424 (published 5-27-2004) which is the parent document for the present invention and WO 95/04730 (published on 02-16-1995). Applicants submit herewith a supplemental Information Disclosure Statement sheet citing the publication numbers instead of the application numbers for these two references.

Rejections under 35 USC §102(b)

Claims 15-17 stand rejected under 35 U.S.C. 102(b) as allegedly anticipated by MacKenzie et al. (United States Patent No. 5,912,244 ("the '244 patent")). Applicants have cancelled claims 15-17 in order to expedite the prosecution of this case.

In view of these amendments, withdrawal of the rejections under 35 U.S.C. §102(b) is respectfully requested.

Rejection under 35 U.S.C. 103(a)

Claims 1-14 stand rejected under 35 U.S.C. 103(a) as obvious in light of the '244 patent. Claim 14 has been cancelled to advance the prosecution of this case.

The Examiner alleges that the '244 patent teaches treatment of 'alopecia'. The '244 patent discloses that the benzopyran derivatives of the '244 patent may be useful in treating male pattern baldness, an androgenic alopecia.

Claims 1 and 13 have been amended to delete the term “female pattern hair loss” which is also an androgenic alopecia. The present invention is now directed to treatment of alopecia areata, hair loss secondary to chemotherapy or radiation treatment, stress-related hair loss, self-induced hair loss, and scarring alopecia, none of which are androgenic alopecia.

Applicants, therefore, request that the rejection of claims 1-14 as obvious under 35 U.S.C. 103(a) in light of the ‘244 patent be reconsidered and withdrawn.

Double Patenting Rejections

Claims 1-11 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-17 of copending U.S. patent application Ser. No. 11/053,008 or No. 2005/0182065. Without acquiescing to the properness of this rejection and solely to advance the prosecution of the present case, Applicants file herewith a terminal disclaimer in compliance with 37 CFR 1.321(c) disclaiming the terminal portion of the statutory term of claims 1-11 issuing from the U.S. patent application Ser. No. 10/699,895 to make it coextensive with corresponding claims of copending U.S. patent application Ser. No. 11/053,008. Applicants respectfully suggest that the double patent rejections are rendered moot and should be withdrawn.

Applicants wish to make of record that at the time the inventions disclosed and claimed in the applications, U.S. Serial No. 10/699,895 and U.S. Serial No. 11/053,008, were made, all of the inventors were under an obligation to assign all rights in their inventions to Warner-Lambert Company LLC and did assign all rights in the inventions disclosed and claimed in the above-identified applications to Warner-Lambert Company LLC. Each of the assignment documents have been recorded in the United States Patent and Trademark Office and are of record in the corresponding files for the patent applications. However, copies of each of these assignment documents will be provided to the Examiner upon request.

Applicants, therefore, request that the rejection of claims 1-11 as obvious under 35 U.S.C. 103(a) in light of U.S. Serial No. 11/053,008 be reconsidered and withdrawn in light of the common ownership of the inventions at the time this invention was made and the continued common ownership of the patent and patent applications.

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at 734-622-4182.

Respectfully submitted,

Dated: Jan. 11, 2007

Rosanne Goodman
Rosanne Goodman
Registration No. 32,534
Warner-Lambert Company LLC
2800 Plymouth Road
Ann Arbor, MI 48105
Telephone: (734) 622-4182
Facsimile: (734) 622-1553